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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,538	04/09/2004	Keith Tanner	RPS6098-D1	1289

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CARDINAL HEALTH
7000 CARDINAL PLACE
LEGAL DEPARTMENT - INTELLECTUAL PROPERTY
DUBLIN, OH 43017

EXAMINER

DEL SOLE, JOSEPH S

ART UNIT	PAPER NUMBER
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1722

DATE MAILED: 01/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/821,538

Applicant(s)

TANNER ET AL.

Examiner

Joseph S. Del Sole

Art Unit

1722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14 and 17 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 14 and 17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/9/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Information Disclosure Statement

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

2. The information disclosure statement filed 4/9/04 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered unless initialed. The Examiner notes that no copy was supplied to the Examiner of document "The Theory and Practice of Industrial Pharmacy".

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 14 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 14 is indefinite because the scope of the claim is unclear. The preamble recites an apparatus for applying a polymer to a substrate but the body of the claim does not recite any structural/ functional relationship between the three-way valved injection wedge and the means to melt a polymer in order to form a function apparatus for handling a substrate and subsequently applying a polymer to the substrate.

Claim 17 is indefinite because the claim does not recite the structural relationship between the hoppers and the melting means or the injection wedge. Furthermore, it is not clear whether the fill lines and return lines are part of the hopper or part of another structure of the claim.

5. Claims 14 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: the structures connecting the polymer melt means to the injection wedge and the hoppers to either the means for melting or the injection wedge; furthermore, there is no structurally relationship between the hoppers and the structures of claim 14 or between the fill line and the return lines and any other structure of the claims.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Parkhideh (5,761,886) in view of AAPA (Applicant's Admitted Prior Art) or Majkrzak (4,919,308).

Parkhideh teaches an apparatus for applying a polymer to a substrate for encapsulation (Fig 1) including an injection wedge (13) having a shut-off valve (27); a hopper (2); an injection line (14) connecting the injection ports of the valved injection wedge with the hopper; and a return line (12) connecting the return port of the valved injection wedge with the hopper.

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Parkhideh fails to teach means to melt the polymer on demand and fails to teach the injection wedge begin a three-way valved wedge.

Majkrzak teaches a melt on demand apparatus (Fig 1, #20) for the purpose of melting once solid polymers before coating a substrate (col 1, lines 10-25). AAPA teach that melt on demand devices are well known in the art for the purpose of forming a film composition (page 17, line 12 - page 18, line 19). AAPA also teaches that a three-way valve is known in the art (page 20, line 17).

It would have been obvious to one having ordinary skill in the art at the time of the Applicant's invention to have modified the apparatus of Parkhideh with a melt on demand apparatus as taught by either Majkrzak or AAPA because it would enable a more easily transported solid material to be used directly at the encapsulation device. It also would have been obvious to one having ordinary skill in the art at the time of the Applicant's invention to have modified the apparatus of Parkhideh by having provided a three way valve, as taught by AAPA, in order to switch from one fill material to another and/or both.

10. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Parkhideh (5,761,886) in view of AAPA (Applicant's Admitted Prior Art) or Majkrzak (4,919,308) and further in view of Chasman (4,567,714).

Parkhideh and either AAPA or Majkrzak teach the apparatus as discussed above.

Parkhideh fails to teach the apparatus having at least two fill hoppers, at least two sets of fill lines and at least two sets of return lines.

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Chasman discloses an apparatus (20) for forming capsules (22) wherein the apparatus is capable of forming capsules of different type of fill material such as powder fill material, liquid fill material or combination thereof (col 30, line 67 - col 31, line 4).

It would have been obvious to one having ordinary skill in the art at the time of the Applicant's invention to have modified the apparatus of Parkhideh by having provided an additional hopper and an additional set of fill and return lines for feeding a different fill material separately, alternately, or in combination as taught by Chasman.

References of Interest

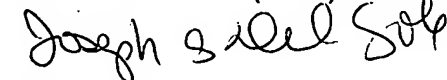
11. Herridge et al (5,660,922) and Doesburg et al (5,520,958) are cited of interest to show the state of the art.

Correspondence

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Joseph S. Del Sole whose telephone number is (571) 272-1130. The examiner can normally be reached on Monday through Friday from 8:30 A.M. to 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Benjamin Utech, can be reached at (571) 272-1137. The official fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306 for both non-after finals and for after finals.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from the either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on the access to the Private PAIR system, contact the Electronic Business Center (EBC) at 886-217-9197 (toll-free).



J.S.D.
December 29, 2004